

Appl. No. 10/563,769
Response dated: June 29, 2007
Reply to O.A. dated: January 29, 2007

REMARKS

Introduction

This Amendment is in response to the Official Action of January 29, 2007 in connection with the above-identified application.

Description of the Amendments to the Claims

Applicant has amended the claims of the instant application as discussed in detail below.

Firstly, Applicant has canceled claims 31-49 without prejudice or disclaimer. Applicant reserves the right to file a continuation application directed to the subject matter of the canceled claims.

Secondly, Applicant has amended claim 50 to merge steps i) and ii), to change roman numerals to letters, to correct the spelling error in the word "continuous," to replace the word "supplementing" with the word "supplying," to replace the word "certain" with the word "selected" and to recite the term "and then" between steps that are to be performed in order. Claims 58 and 60 have also been amended to make similar changes. Applicant respectfully submits that the amendments to the claims are supported by the specification as originally filed. Specifically, Applicant notes page 13, lines 1-3, which clearly sets forth that the order of adding the ingredients be performed sequentially.

Finally, Applicant has added new claims 63-66. New claim 63 depends from claim 51, and recites that the spongy material of claim 51 is spherical in form polystyrene. Support for new claim 63 may be found at, e.g., page 9, lines 7-10 of the specification as originally filed. New claim 64 recites a water-based hardenable mixture intended to realise soundproofing agglomerates obtained through the method recited in claim 50. Support for new claim 64 may be found at, e.g., page 11, lines 4-14 of the specification as originally filed. New claim 65 recites the product obtained by the method of claim 50 and further comprising cork. Support for new claim 65 may be found at, e.g., page 12, lines 14 and 15 of the specification as originally filed. New

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claim 66 recites the product obtained by the method of claim 50, and further comprising a coloured pigment. Support for new claim 66 may be found at, e.g., page 12, lines 16 and 17 of the specification as originally filed.

Applicant respectfully submits that all claims now pending in the instant application are in compliance with the requirements of 35 U.S.C. §112 and are patentable over the references of record.

Response to the Objections to the Claims

The Official Action begins by objecting to claim 34 due to certain informalities. Specifically, the Official Action urges that the division signs in claim 34 should be replaced by hyphens. In response, Applicant respectfully notes that claim 34 has been canceled from the instant application, thereby rendering the objection to claim 34 moot. Accordingly, Applicant respectfully requests that this objection be withdrawn.

Response to the Rejection Under §112, Second Paragraph

The Official Action rejects claims 35-37, 41 and 43 under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Official Action urges that the use of the terms "or the like", "transforming" and "or similar materials" in the claims identified above renders the claims indefinite. In response, Applicant notes that claims 35-37, 41 and 43 have been canceled from the instant application, thereby rendering the indefiniteness rejection moot. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Response to the Rejections Under §102(b)

The Official Action rejects claims 31-33, 40, 41, 47-50 and 53-55 under 35 U.S.C. §102(b) as being anticipated by Shi et al. (US Pub. Pat. App. No. 2002/0117086). Applicant notes that while claims 44 and 45 are not included in the group of claims identified as being anticipated by Shi set forth at the top of page 3 of the Official Action, claims 44 and 45 are discussed in the text of this rejection (see top of page 4 of the Official Action). Accordingly, for the purpose of responding to the

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outstanding Official Action, Applicant is treating claims 44 and 45 as being included within the §102(b) rejection over Shi.

Firstly, with respect to the §102(b) rejection of claims 31-33, 40, 41, 44, 45 and 47-49 over the Shi reference, Applicant respectfully notes that claims 31-33, 40, 41, 44, 45 and 47-49 have been canceled from the instant application, thereby rendering the §102(b) rejection over Shi moot. Accordingly, Applicant respectfully requests that the anticipation rejection of these claims be withdrawn.

With respect to the rejection of claims 50 and 53-55 under 35 U.S.C. §102(b) as being anticipated by Shi, Applicant respectfully traverses the rejection of these claims in light of the following comments.

Applicant wishes to begin by directing attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

With respect to claim 50, the Official Action urges that Shi discloses a method of making fiber-reinforced cellular lightweight concrete, said method comprising mixing cement, fiber, a specific lightweight aggregate, lime, a gas-forming or foaming agent and a shrinkage reducing agent in a conventional concrete mixer to form a thick and viscous slurry which can be foamed and hardened at room or elevated temperatures. In view of this disclosure, the Official Action urges that Shi discloses each of the elements recited in claim 50.

In response, Applicant respectfully submits that, in asserting that Shi discloses the method recited in the instant application, the Official Action has overly generalized

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the method recited in claim 50 and ignored elements of the claimed invention. Specifically, the Official Action has treated the method recited in claim 50 as a group of steps that can be performed in any order. However, such a reading of claim 50 ignores the recitation of a method comprising performing a sequence of steps in the exact order set forth in the claim. The Official Action also appears to have ignored the recitation in claim 50 of adding a second quantity of cement into the mixer after sequentially adding water, cement, cellulose and air.

Claim 50 clearly recites that the materials of the soundproofing agglomerate are sequentially added in the following order: water; cement; cellulose; air; cement. To the contrary, Shi discloses a first method wherein the components of the concrete are added in the following order: cement, water, cellulose, gas forming agent. Shi also discloses a second method wherein the components of the concrete are added in the following order: foaming agent, water, pre-mixed cement and cellulose. Thus, a simple comparison of the order of steps claimed in the instant application and the order of steps disclosed in Shi reveals that Shi does not disclose the same order of performing steps as recited in claim 50 of the instant application. Furthermore, it is clear that neither method disclosed in Shi comprises two separate steps of adding cement as recited in claim 50 of the instant application. Accordingly, because Shi fails to disclose each and every element of the claimed invention, Applicant respectfully submits that the reference is incapable of properly supporting a §102(b) rejection according to the guidelines set forth in MPEP §2131. Applicant therefore respectfully requests that the anticipation rejection of claim 50 and claims 53-55 depending therefrom be withdrawn.

With respect to the anticipation rejection of claim 54 over Shi, the Official Action generally refers to paragraphs [0029], [0037], [0039], [0040], [0042], [0043], [0040], [0046], [0053], [0057] and [0058] as disclosing the element of preparing the foam component of the soundproofing agglomerate by mixing soap with water. However, Applicant's careful review of these paragraphs and the Shi reference in general indicates that a soap and water foaming agent is not disclosed in Shi. Rather, Shi only appears to disclose alkaline salts of natural wood resins, alkaline salts of fatty acids and alkaline salts of sulfonated organic compounds as foaming agents. Accordingly,

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Applicant respectfully requests that the anticipation rejection of claim 54 over Shi be withdrawn.

The Official Action also rejects claims 35-37, 46 and 60 under 35 U.S.C. §102(b) as being anticipated by Barbosa (US Pat. No. 6,730,160). Applicant notes that claims 35-37 and 46 depend from claim 31 and claim 60 depends from claim 50, yet neither claim 31 nor claim 50 is included in the anticipation rejection over Barbosa. Applicant assumes for purposes of responding to the outstanding Official Action that claims 31 and 50 are included in the §102(b) rejection over Barbosa.

With respect to the anticipation rejection of claims 31, 35-37 and 46, Applicant notes that these claims have been canceled from the instant application, thereby rendering the rejection over Barbosa moot. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

With respect to the anticipation rejection of claims 50 and 60 over Barbosa, the Official Action urges that Barbosa discloses a mixture of water and cellulose fibers, both of which can be comprised of readily available materials at the job site, such as the available water supply or natural water and scrap shredded paper, including newspaper or other discarded paper or cardboard materials, wherein said mixture is directed to the manufacture of structural insulating building materials. The Official Action also notes that Barbosa discloses that colored pigments and aggregates may be added for appearance.

In response, Applicant notes first and foremost that the Barbosa reference fails to disclose a mixture comprising cement. In fact, Barbosa goes so far as to expressly disclose that the mixture does not comprise cement (see, e.g., col. 6, lines 49-52). Accordingly, because the reference does not disclose cement (and expressly excludes cement) as a component, Applicant respectfully submits that Barbosa is incapable of disclosing a method for preparing a soundproofing agglomerate where the method requires the addition of cement at two different points during the method.

Furthermore, and as discussed in greater detail above, claim 50 of the instant application is drawn to a sequence of steps performed in the specified order. To the contrary, Barbosa expressly discloses that the ingredients of the building material are

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added in no specific order. Barbosa explains that, after mixing cellulose with water, the remaining components are added in no particular order (see, e.g., col. 7, lines 1 and 2). Accordingly, even assuming Barbosa disclosed cement as a component of the material, the reference would still fail to adequately disclose the sequence of steps recited in claim 50 of the instant application.

Because Barbosa fails to disclose each and every element of the claimed invention, Applicant respectfully submits that the reference is incapable of properly supporting a §102(b) rejection according to the guidelines set forth in MPEP §2131. Applicant therefore respectfully requests that the anticipation rejection of claim 50 and claim 60 depending therefrom be withdrawn.

Response to the Rejection Under §103(a)

The Official Action rejects claims 34, 38, 39, 42, 43, 51, 52, 56-59, 61 and 62 under 35 U.S.C. §103(a) as being unpatentable over Shi as applied to claims 31-33 in the §102(b) rejection discussed above and further in view of Symons (US Pub. Pat. App. No. 2003/0055132).

Firstly, with respect to claims 34, 38, 39, 42 and 43, Applicant respectfully notes that these claims have been canceled from the instant application, thereby rendering the §103(a) rejection of the claims moot. Accordingly, Applicant respectfully requests that the §103(a) rejection of these claims be withdrawn.

With respect to the rejection of claims 51, 52, 56-59, 61 and 62, Applicant notes that claims 51, 52, 56-59, 61 and 62 depend from claim 50, yet the Official Action does not expressly state that these claims are rejected as being unpatentable over Shi as applied to claim 50 and in further view of Symons. For purposes of responding to the Official Action, Applicant assumes that the rejections of claims 51, 52, 56-59, 61 and 62 are based upon the anticipation rejection of claim 50 over Shi set forth in the outstanding Official Action and further in view of Symons.

As discussed in detail above, the rejection of claim 50 over Shi is defective for several reasons. Shi fails to disclose both the specific order of steps recited in claim 50 and also the second addition of cement after sequentially mixing water, cement,

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cellulose and air. Thus, the rejection of claims 51, 52, 56-59, 61 and 62 as being obvious over Shi as applied to claim 50 and further in view of Symons is defective from an initial standpoint because the obviousness rejection depends upon as its basis an anticipation rejection that fails to disclose every element of the independent claim from which claims 51, 52, 56-59, 61 and 62 depend.

Furthermore, Applicant respectfully submits that Symons fails to remedy the deficiencies identified above with respect to Shi. The Official Action relies upon Symons as teaching polystyrene foam in a water-based hardenable cement mixtures. More specifically, Applicant notes Symons discloses a method comprising adding in sequence cellulose (i.e., feedstock), air (i.e., polystyrene foam) and cement (i.e., hydraulic binder), followed by compressing the mixture into a mat and optionally adding water. Thus, it is evident that the method of Symons fails to disclose or suggest the specific order of adding water, cement, cellulose, air, and cement as recited in claim 50 and also fails to disclose two separate steps of adding cement as recited in claim 50. Accordingly, even though Symons may teach polystyrene foam in a cement mixture as alleged in the Official Action, the reference fails to disclose or suggest the elements of the claimed invention which Shi fails to disclose.

In view of the above discussion, Applicant respectfully submits that Shi and Symons, either standing alone or when taken in combination, fail to disclose or suggest every element of independent claim 50 and claims 51, 52, 56-59, 61 and 62 depending therefrom. Applicant therefore respectfully submits that the references are incapable of properly establishing a §103 rejection according to the guidelines set forth in MPEP §2143 and §103 rejection of claim 50 and 60 over these references should be withdrawn.

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Conclusion

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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